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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,341	11/20/2001	Scott Montgomery	703602.2	2692

34313 7590 06/28/2007  
ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
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EXAMINER
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ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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06/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/990,341

Applicant(s)

MONTGOMERY ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34,36-49,51-56 and 58-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34,36-49,51-56 and 58-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
  - Claims 1, 27, 46, and 53 are amended.
  - Claims 35, 50, and 57 are canceled.
  - Claim 65 is added
  - Claims 1-34, 36-49, 51-56, and 58-65 are pending.
2. Examiner is withdrawing the objections to claims 27 and 53 due to the amendments made by the applicant.
3. Rejections of claims 27 and 53 under 35 U.S.C. 112 2<sup>nd</sup> paragraph has been withdrawn based on the amendments made by the applicant.

### ***Response to Arguments***

4. As an initial matter there was no acknowledgement or clarification to the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a), was brought up by the examiner in the last office action that was mailed on October 23, 2006.
5. Applicant's arguments filed April 19, 2007 have been fully considered but they are not persuasive for the following reasons:
6. In response to applicant argument regarding rejection of independent claims 1, 14, 27, and 39 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 6,005,945 to Harry Whitehouse in view of U.S. Patent Application Publication No. 2005/0209976 to William F. Bailey. As per discussion raised by the applicant in regards to that Whitehouse does not disclose validating the postage of the mail piece based on indicia located on a database. Examiner respectfully disagrees with the applicant. Whitehouse clearly discloses such retrieval and verification of the indicia (data record stored) in a database as to

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verify the validity of the mail pieces postage indicia. However. As it was clearly articulated in the rejection below the retrieval is by scanning of the indicia itself in the database for verification that clearly discloses the use of a serial number (tracking ID), also one can clearly argue that such indicia itself is based on a numerical value that it clearly can be labeled as an "identifier" or "ID". Furthermore, the examiner specifically has brought the teachings of Bailey to clarify the fact that using a tracking ID for retrieval of information on validity of a postage indicia or mail piece postage information is known in the art and has been practiced in various ways to accomplish such task. Also it is clear in both Whitehouse and Bailey references that the data is stored in a central database for later retrieval of information related to the postage indicia and so on. It would have been clearly within on skilled in the art to even store a digital copy of the entire image printed on the mail piece at the central data facility for comparison. It does not make any difference to the machine reading the information from the mail piece of what form of data is being compared in the computer world the entire information being a simple tracking number or a complex image would be translated into bits of information in binary number and stored, retrieved or compared. Also, if the applicant is interpreting the "retrieval of the indexed postage indicium" as looking up within a database of an actual image or a JPG file representing the *stamp or image form* of the indicia, that is not what is reflected in the claims. As well as the examiner has not been able to substantiate any support for such limitation within the specification disclosure.

7. In response to applicant argument regarding rejection of independent claims 46, 53, and 60 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 6,005,945 to Harry Whitehouse in view of U.S. Patent Application Publication No. 2005/0209976 to William F. Bailey and further in view of U.S. Patent Application No. 2001/0056469 to Takasi Oonuki. Again the practice of requesting the information about the sender of the mail piece by using an identifier or ID of sender of the mail piece can be clearly seen in the Oonuki reference (See Oonuki Figure 9 and paragraphs [0071]-[0080]). It is clearly shown that the recipient of a mail (here e-mail) that contains an ID can request information on the sender of the mail.

8. Subsequent claims are substantially the same as the discussed claims, therefore the same above arguments are applicable towards them.

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***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. As per claim 46, it is not clear of who is receiving, retrieving and then transmitting the identification information. Applicant has not pointed out or clarified who or at what step the exchanges of information is taking place amongst the different entities involved in the process. There is no indication in the claim as what entity is generating and associating the tacking ID with the sender identification. It is not clear or any indication of what entity is receiving a sender identification request. Further clarification is required.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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13. Claims 1-34, 36-49, 51-56, and 58-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,005,945 to Harry Whitehouse in view of U.S. Patent Application Publication No. 2005/0209976 to William F. Bailey.

14. As for claim 1, Whitehouse clearly discloses a method of indexing a postage indicium within a database of a centralized postage-issuing computer system, the method comprising:

- generating a postage indicium associated with a mail piece (See Whitehouse column 2, lines 1-52);
- associating an indexing tracking ID with the postage indicium (See Whitehouse column 2, lines 43-52, column 13, lines 15-65 and column 14, line 66- column 15, line 17); and
- storing the indexed postage indicium within the database (See Whitehouse column 8, line 4- column 9, line 31, column 10, line 45- column 11, line 36) of a centralized postage issuing computer system;
- applying the indexing tracking ID to the mail piece (See Bailey paragraph [0019]);
- reading the indexing tracking ID on the mail piece (See Bailey paragraph [0019]); and
- retrieving the indexed postage indicium from the database based on the read indexing tracking ID to validate the postage (See Bailey paragraphs [0020]-[0029]).

What is not specific by the Whitehouse is the associating an indexing tracking ID with the postage indicium. However, Bailey clearly teaches that the tracking information such as a unique tracking ID is generated and stored in a database for identification of the mail piece (See Bailey paragraphs [0023]-[0025], and [0029]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate the teachings of Bailey into that of Whitehouse for enhancing and speeding the lookup and identification of related information to that of the data associated with the indicium.

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15. As for claim 2, Whitehouse and Bailey disclose the method of claim 1, wherein the indexing tracking ID is unique within a postal service (See Whitehouse column 6, lines 1-18, column 10, line 45- column 11, line 29, column 13, lines 15-65 and column 21, lines 11-48).

16. As for claim 3, Whitehouse and Bailey disclose the method of claim 2, wherein the postal service is the United States Postal Service (See Whitehouse column 6, lines 1-18).

17. As for claim 4, Whitehouse and Bailey disclose the method of claim 1, wherein the postage indicium comprises one or more items selected from the group consisting of postage amount, date and time of postage information creation, service class, optional data advance, and delivery zip code (See Whitehouse column 13, lines 19-46).

18. As for claim 5, Whitehouse and Bailey disclose the method of claim 1, further comprising:  
deriving a digital signature from the postage indicium (See Whitehouse column 13, lines 15-65 and column 14, line 66- column 15, line 17);

associating the digital signature with the postage indicium to generate an indexed self-validating postage indicium (See White house column 13, lines 15-65 and column 17, line 60- column 18, line 11);  
and

storing the indexed self-validating postage indicium within the centralized postage-issuing computer system (See Whitehouse column 8, line 4- column 9, line 31, column 10, line 45- column 11, line 36).

19. As for claim 6, Whitehouse and Bailey disclose the method of claim 5, wherein the digital signature association comprises attaching the digital signature to the postage indicium (See Whitehouse column 13, lines 55-59).

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20. As for claim 7, Whitehouse and Bailey disclose the method of claim 5, wherein the digital signature is generated by applying a private key to the postage indicium (See Whitehouse column 13, lines 37-65).

21. As for claim 8, Whitehouse and Bailey disclose the method of claim 5, wherein the indexed self-validating postage indicium is generated within a physically secure coprocessor device (See Whitehouse column 3, lines 48-54, column 8, lines 23-62).

22. As for claim 9, Whitehouse and Bailey disclose the method of claim 1, further comprising: receiving an indexing identifier request from an end user computer; and transmitting the indexing tracking ID to the end user computer (See Whitehouse column 6, lines 30-65).

23. As for claim 10, Whitehouse and Bailey disclose the method of claim 1, further Keubert discloses ; receiving a postage indicium request containing the indexing tracking ID from a postal authority (See Whitehouse column 2, lines 1-52); retrieving the indexed postage indicium from the database based on the received indexing tracking ID (See White house column 13, lines 15-65 and column 17, line 60-column 18, line 11); and transmitting the indexed postage indicium to the postal authority (See Whitehouse column 8, line 4-column 9, line 31, column 10, line 45- column 11, line 36).

24. As for claim 11, Whitehouse and Bailey disclose the method of claim 1, further comprising: generating a plurality of postage indicia associated with a plurality of mail pieces; associating a plurality of indexing tracking IDs with the plurality of postage indicia; and storing the plurality of indexed postage indicia within the database (See Whitehouse column 6, lines 30-65).

25. As for claim 12, Whitehouse and Bailey disclose the method of claim 11, further comprising: receiving a plurality of indexing identifier requests from a plurality of end user computers; and transmitting the plurality of indexing tracking IDs to the plurality of end user computers.



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26. As for claim 13, Whitehouse and Bailey disclose the method of claim 11, further comprising:  
receiving a plurality of postage indicium requests containing the plurality of indexing tracking IDs from a postal authority (See Whitehouse column 2, lines 1-52);  
retrieving the plurality of indexed postage indicia from the database based on the plurality of received indexing tracking IDs (See White house column 13, lines 15-65 and column 17, line 60- column 18, line 11); and  
transmitting the plurality of indexed postage indicia to the postal authority (See Whitehouse column 8, line 4-column 9, line 31, column 10, line 45- column 11, line 36).

27. As per claims 14-34, 36-45 and 65, all the claims are substantially claiming the same limitations as claims 1-13 above, therefore, the rejections provided above applies to the current limitations of claims 14-34, 36-45 and 65.

28. Claims 46-49, 51-56, and 58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,005,945 to Harry Whitehouse in view of U.S. Patent Application Publication No. 2005/0209976 to William F. Bailey further in view of U.S. Patent Application No. 2001/0056469 to Takasi Oonuki.

29. As for claim 46, 53 and 60, Whitehouse clearly discloses a method of indexing sender identification information within a database of a centralized postage-issuing computer system, the method comprising:

generating sender identification information associated with a mail piece See Whitehouse column 2, lines 43-52, column 13, lines 15-65 and column 14, line 66- column 15, line 17);

associating an indexing tracking ID with the sender identification information (See Whitehouse column 8, line 4-column 9, line 31, column 10, line 45- column 11, line 36);

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storing the indexed sender identification information within the database (See Whitehouse column 8, line 4-column 9, line 31, column 10, line 45- column 11, line 36 and Bailey paragraphs [0020]-[0029]);

receiving a sender identification request containing the indexing tracking ID from a mail recipient computer;

retrieving the sender identification information from the database based on the received indexing tracking ID; and

transmitting the sender identification information to the mail recipient computer to verify the sender.

What is not specific by the Whitehouse is the associating an indexing tracking ID with the postage indicium. However, Bailey clearly teaches that the tracking information such as a unique tracking ID is generated and stored in a database for identification of the mail piece (See Bailey paragraphs [0023]-[0025], and [0029]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate the teachings of Bailey into that of Whitehouse for enhancing and speeding the lookup and identification of related information to that of the data associated with the indicium. Further what is not explicit in Whitehouse and Bailey references is the requesting, retrieving and transmitting sender information to a recipient by way of looking up the sender information in a database based on a identifier or ID. However, Oonuki clearly teaches such transaction in a mailing system (See Oonuki Figure 9 and paragraphs [0071]-[0080]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate the teachings of Oonuki into that of Bailey and Whitehouse for the motivation of providing information for security of having a trusted entity or person to forward you mail and to enhance the identification of whom one is receiving mail from.

30. As per claims 47-49, 51-52, 54-56, 58-59 and 61-64, all the claims are substantially claiming the same limitations as claims 2-13 above, therefore, the rejections provided above applies to the current limitations of claims 47-49, 51-52, 54-56, 58-59 and 61-64.

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31. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (571) 272-6702. The examiner can normally be reached on 10 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fischer Andrew can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kambiz Abdi

Primary Examiner

June 20, 2007

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